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Greg Goshorn, P.C. 9600 Escarpment Suite 745-9 AUSTIN, TX 78749			EXAMINER CAO, PHUONG THAO	
			ART UNIT 2164	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/798,904

**Applicant(s)**

MCARDLE, JAMES MICHAEL

**Examiner**

Phuong-Thao Cao

**Art Unit**

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 14-19, 21, 22 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-19, 21, 22 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to Amendment filed on 9/10/2007.
2. Claims 1, 8, 10-12, 14, 15, 21 and 25 have been amended, and claims 6, 13, 20, 23 and 24 have been cancelled. Currently, claims 1-5, 7-12, 14-19, 21, 22 and 25 are pending.

#### ***Response to Amendment***

3. Amendments to claims 10-14 are effective to overcome the 112, 2<sup>nd</sup> paragraph rejection in the previous office action. Therefore, the 112, 2<sup>nd</sup> paragraph rejection has been withdrawn.

#### ***Response to Arguments***

4. Applicant's arguments filed on 9/10/2007 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Denoue et al. does not teach nor suggest "inserting the metadata into a second destination document rather than the first destination document, wherein the second destination document is associated with the first destination document", Examiner disagrees. Denoue et al. teaches in paragraph [0091] that data information (element) captured by the printing device is printed along with an identifier (i.e., barcode), and metadata accessed by scanning the barcode can be printed elsewhere (i.e., on another paper) wherein the

paper containing the printed data information is broadly interpreted as a first destination document, the other paper containing the printed metadata is broadly interpreted as a second destination document, and the barcode represents the association between the two documents. In addition, Denoue et al. also discloses in [0092] that metadata accessed by scanning the barcode can be transferred to another medium, which indicates that metadata must be stored as a file in the other medium (second destination) which is definitely separate from the printed data information (first destination).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-12, 14-19, 21 and 22 (effective filing date 3/11/2004) are rejected under 35 U.S.C. 103(a) as being unpatentable over Gulati et al. (US Patent No 6,924,827, effective filing date 12/28/1999) in view of Denoue et al. (Publication No US 2003/0051615, effective filing date 9/14/2001).

As to claim 1, Gulati et al. teach:

“A method for tracking metadata related to an information object inserted into a document” (see Gulati et al., [column 3, lines 1-5]) the method comprising the steps of:

“compiling metadata describing an information object collected from a source document” (see Gulati et al., [column 5, lines 5-15] and [column 16, lines 1-10] for capturing additional metadata);

“storing the metadata and the corresponding information object in a memory” (see Gulati et al., [column 5, lines 15-25] and [column 6, lines 10-20]); and

“inserting the information object into a first destination document” (see Gulati et al., [column 6, lines 14-18] for cutting and pasting data between applications).

However, Gulati et al. does not teach “inserting the metadata into a second destination document, wherein the second destination document is associated with the first destination document”.

Denoue et al. teach “inserting the metadata into a second destination document, wherein the second destination document is associated with the first destination document” (see Denoue et al., [0091] teaches data information (element) captured by the printing device is printed along with an identifier (i.e., barcode), and metadata accessed by scanning the barcode can be printed elsewhere (i.e., on another paper) wherein the paper or medium containing the printed data information is broadly interpreted as a first destination document, the other paper or medium containing the printed metadata is broadly interpreted as a second destination document, and the barcode (i.e., identifier) represents the association between the two documents (i.e., printed data information and printed metadata)).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate teaching of Denoue et al. into Gulati et al.'s system. A skilled artisan would have been motivated to do so to provide one more flexible and effective way to manage and access the metadata associated with captured data. Both Gulati et al. and Denoue et al. implement a system, which allows gathering data from various sources, and tracking and attributing such data used to its original source. This close relation between the two references highly suggests an expectation of suggest.

As to claim 2, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the first destination document is a word processing document” (see Gulati et al., [column 2, lines 1-5]).

As to claim 3, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the information object is computer source code” (see Gulati et al., [column 7, lines 65-67] and [column 8, lines 1-10] wherein any electronic data or data object is equivalent to Applicant's “computer source code”).

As to claim 4, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the metadata includes information providing attribution for the information object” (see Gulati et al., [column 3, lines 1-5] and [column 5, lines 10-15]).

As to claim 5, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the metadata includes information related to the source document” (see Gulati et al., [column 16, lines 1-10]; also see Denoue et al., [0092]).

As to claim 7, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the metadata is not viewable during at least one processing phase of the first destination document” (see Gulati et al., [column 15, lines 20-30] wherein metadata such as bibliographic data is only viewable when requested by the user).

As to claim 8, Gulati et al. teach:

“A system for tracking metadata related to an information object inserted into a document” (see Gulati et al., [column 1, lines 30-40], [column 3, lines 1-5] and [column 15, lines 55-65]), comprising:

“a computing system” (see Gulati et al., [column 4, lines 45-55]);

“a source document” (see Gulati et al., [column 8, lines 1-20]);

“a first destination document” (see Gulati et al., [column 6, lines 10-20] and [column 16, lines 20-30] wherein requesting application or target application is equivalent to Applicant’s “first destination document”);

“an information object collected from the source document” (see Gulati et al., [column 5, lines 1-15] and [column 7, lines 65-67] wherein captured electronic data is equivalent to Applicant’s “information object”);

“a metadata object describing the information object” (see Gulati et al., [column 5, lines 5-15] and [column 12, lines 17-20] wherein gem data object, which contains metadata describing or referring to the original data is equivalent to Applicant’s “metadata object”); and

“logic, executed on the computing system, for inserting the information object into the first destination document” (see Gulati et al., [column 6, lines 14-18] for cutting and pasting data between applications).

However, Gulati et al. does not teach”

“a second destination document”; and

“logic, executed on the computing system, for inserting the metadata into a second destination document, wherein the second destination document is associated with the first destination document”.



Denoue et al. teach “inserting the metadata into a second destination document, wherein the second destination document is associated with the first destination document” (see Denoue et al., [0091] teaches data information (element) captured by the printing device is printed along with an identifier (i.e., barcode), and metadata accessed by scanning the barcode can be printed elsewhere (i.e., on another paper) wherein the paper or medium containing the printed data information is broadly interpreted as a first destination document, the other paper or medium containing the printed metadata is broadly interpreted as a second destination document, and the barcode (i.e., identifier) represents the association between the two documents (i.e., printed data information and printed metadata)).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate teaching of Denoue et al. into Gulati et al.’s system. A skilled artisan would have been motivated to do so to provide one more flexible and effective way to manage and access the metadata associated with captured data. Both Gulati et al. and Denoue et al. implement a system, which allows gathering data from various sources, and tracking and attributing such data used to its original source. This close relation between the two references highly suggests an expectation of suggest.

As to claim 9, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the first destination document is a word processing document” (see Gulati et al., [column 2, lines 1-5]).

As to claim 10, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the information object is computer source code” (see Gulati et al., [column 7, lines 65-67] and [column 8, lines 1-10] wherein any electronic data or data object is equivalent to Applicant’s “computer source code”).

As to claim 11, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the metadata includes information providing attribution for the information object” (see Gulati et al., [column 5, lines 10-15] and [column 16, lines 1-10]).

As to claim 12, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. teach:

“wherein the metadata includes information related to the source document” (see Gulati et al., [column 16, lines 1-10]).

As to claim 14, this claim is rejected based on arguments given above for rejected claim 8 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the metadata is not viewable during at least one processing phase of the first destination document” (see Gulati et al., [column 15, lines 20-30] wherein metadata such as bibliographic data is only viewable when requested by the user).

As to claim 15, Gulati et al. teach:

“A computer program product for tracking metadata related to an information object inserted into a document” (see Gulati et al., [column 1, lines 30-37], [column 5, lines 1-15] and [column 6, lines 13-20]), comprising:

“a recording medium” (see Gulati et al., [column 4, lines 55-60]);

“means, stored on the recording medium, for compiling metadata describing an information object collected from a source document” (see [column 5, lines 5-15] for capturing additional metadata, as illustrated in Applicant’s claim language);

“means, stored on the recording medium, for storing the metadata and the corresponding information object in a memory” (see Gulati et al., [column 5, lines 15-25] and [column 6, lines 10-20]); and

“means, stored on the recording medium, for inserting the information object into the first destination document” (see Gulati et al., [column 6, lines 14-18] for cutting and pasting data between applications).

However, Gulati et al. does not teach “means, stored on the recording medium, for inserting the metadata into a second destination document, wherein the second destination document is associated with the first destination document”.

Denoue et al. teach “means, stored on the recording medium, for inserting the metadata into a second destination document, wherein the second destination document is associated with the first destination document” (see Denoue et al., [0091] teaches data information (element) captured by the printing device is printed along with an identifier (i.e., barcode), and metadata accessed by scanning the barcode can be printed elsewhere (i.e., on another paper) wherein the paper or medium containing the printed data information is broadly interpreted as a first destination document, the other paper or medium containing the printed metadata is broadly interpreted as a second destination document, and the barcode (i.e., identifier) represents the association between the two documents (i.e., printed data information and printed metadata)).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate teaching of Denoue et al. into Gulati et al.'s system. A skilled artisan would have been motivated to do so to provide one more flexible and effective way to manage and access the metadata associated with captured data. Both Gulati et al. and Denoue et al. implement a system, which allows gathering data from various sources, and tracking and attributing such data used to its original source. This close relation between the two references highly suggests an expectation of suggest. (see [column 6, lines 1-20] and [column 16, lines 1-30] wherein requesting application or target application is equivalent to Applicant's “first destination document”).

As to claim 16, this claim is rejected based on arguments given above for rejected claim 15 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the first destination document is a word processing document” (see Gulati et al., [column 2, lines 1-5]).

As to claim 17, this claim is rejected based on arguments given above for rejected claim 15 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the information object is computer source code” (see Gulati et al., [column 7, lines 65-67] and [column 8, lines 1-10] wherein any electronic data or data object is equivalent to Applicant’s “computer source code”).

As to claim 18, this claim is rejected based on arguments given above for rejected claim 15 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the metadata includes information providing attribution for the information object” (see Gulati et al., [column 5, lines 10-15] and [column 16, lines 1-10]).

As to claim 19, this claim is rejected based on arguments given above for rejected claim 16 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

“wherein the metadata includes information related to the source document” (see Gulati et al., [column 16, lines 1-10]).

As to claim 21, Gulati et al. teach:

“A method for compiling and storing metadata” (see Gulati et al., [column 5, lines 15-25] and [column 12, lines 15-35]), comprising the steps of:

“compiling metadata corresponding to an information object collected from a source document, wherein the metadata is information related to the information object” (see Gulati et al., [column 5, lines 5-15] wherein captured electronic data is equivalent to Applicant’s “information object” and capturing metadata is equivalent to compiling metadata as illustrated in Applicant’s claim language); and

“inserting the information object into the first destination document” (see Gulati et al., [column 6, lines 13-20] wherein the requesting application is equivalent to Applicant’s “first destination document and pasting data means inserting data or the information object as illustrated in Applicant’s claim language).

However, Gulati et al. does not teach “storing the metadata in a second destination document such that the second destination document is correlated with the first destination document”.

Denoue et al. teach “storing the metadata in a second destination document such that the second destination document is correlated with the first destination document” (see Denoue et al., [0091] teaches data information (element) captured by the printing device is printed along with an identifier (i.e., barcode), and metadata accessed by scanning the barcode can be printed elsewhere (i.e., on another paper) wherein the paper or medium containing the printed data information is broadly interpreted as a first destination document, the other paper or medium containing the printed metadata is broadly interpreted as a second destination document, and the

barcode (i.e., identifier) represents the association between the two documents (i.e., printed data information and printed metadata)).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate teaching of Denoue et al. into Gulati et al.'s system. A skilled artisan would have been motivated to do so to provide one more flexible and effective way to manage and access the metadata associated with captured data. Both Gulati et al. and Denoue et al. implement a system, which allows gathering data from various sources, and tracking and attributing such data used to its original source. This close relation between the two references highly suggests an expectation of suggest. (see [column 6, lines 1-20] and [column 16, lines 1-30] wherein requesting application or target application is equivalent to Applicant's "first destination document").

As to claim 22, this claim is rejected based on arguments given above for rejected claim 21 and is similarly rejected including the following:

Gulati et al. and Denoue et al. teach:

"wherein the metadata is information related to the source of the information object" (see Gulati et al., [column 16, lines 1-10]).

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 25 (effective filing date 3/11/2004) is rejected under 35 U.S.C. 102(e) as being anticipated by Denoue et al. (Publication No US 2003/0051615, effective filing date 9/14/2001).

As to claim 25, Denoue et al. teaches:

“A method of accessing metadata and associating the metadata with an information object” (see Denoue et al., [0091] and [0092]), comprising the steps of:

“assessing a first document” (see Denoue et al., [0091] wherein the printed content with a barcode is interpreted as a first document) ; and

“retrieving a metadata object, stored in conjunction with the first document and associated with an information object included in a second document, wherein the metadata object includes information relating to the source of the information object and the first document is associated with the second document” (see Denoue et al., [0091] and [0092] for retrieving metadata by scanning the barcode wherein barcode or identifier is used as an association between data information and its metadata which could be printed on two separate paper or media (first and second document)).



*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong-Thao Cao whose telephone number is (571) 272-2735. The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuong-Thao Cao  
Art Unit 2164  
November 9, 2007

  
CHARLES RONES  
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